

REMARKS

New Claims 44 - 47 are added herein. Claims 1 and 18 are amended herein. Claims 1-47 are pending. The Commissioner is authorized to charge the Applicants' account, Deposit Account No. 05-1328, for any fees required by the addition of the new claims or this response.

The following remarks are offered in response to the Second Official Action dated June 16, 2003. Reconsideration and reexamination of this application is respectfully requested in view of the amendments to Claims 1 and 18 and the following remarks. In addition new Claims 44 - 47 are added to claim additional embodiments of the invention described in the specification. New Claims 35 - 43 are not added to overcome the rejections contained in the First Office Action or to comply with any statutory requirement for patentability, but only to claim certain embodiments of the invention which are described in the specification. The support for the amendments to Claims 1 and 18 can be found in on Page 3, Paragraph 14, Page 4, Paragraph 15 and Page 5, Paragraph 17. The support for new Claims 44 through 47 is found on Page 3, Paragraph 14, Page 4, Paragraph 15 and Page 5, Paragraph 17.

In the Office Action, the Examiner made the following rejections:

Claims 1, 2, 4, 7-10, 13-19, 21, 24-27, and 30-34 were rejected under 35 U.S.C §102 as being anticipated by U.S. 4,646,840 to Bartholomew et al. ("Bartholomew");

Claims 3 and 20 were rejected under 35 U.S.C §103 as being obvious over Bartholomew in view of U.S. 4,477,207 to Johnson ("Johnson");

Claims 11, 12, 28 and 29 were rejected under 35 U.S.C §103 as being obvious over Bartholomew in view of U.S. 5,477,392 to Marshall ("Marshall").

Additionally, Claims 5,6, 22, 23 and 35-38 were indicated as containing allowable subject matter but were objected to because they depend from rejected base claims. Claims 39-43 were indicated as allowable. The Applicants gratefully acknowledge the allowable subject matter.

During a personal interview conducted August 11, 2003, the Applicants, represented by Douglas J. Collins, and Examiner Lee discussed the rejections contained in the Second Office Action and the Bartholomew reference. The Applicants proposed amending Claim 1 to include a statement that the frame of the buoyancy apparatus was suitable for accepting external loads. Examiner Lee found the proposed language lacking clarity and suggested that the Applicants propose alternate claim language.

The Applicants hereby submit amendments to Claims 1 and 18 that are related to the discussion during the interview and contain further clarity. Additionally, Claims 44 and 45 contain further specification of certain types of loads that are exerted by external forces that may be carried by the frame of a buoyancy apparatus. Claims 1 and 18, as amended, are not taught or suggested by the references of record and are believed allowable over such references. As claimed in Claim 1 and the claims that depend therefrom, the Applicants' invention includes:

- 1) A buoyancy apparatus for providing tension for an offshore riser comprising:
 - a) at least one buoyancy element; and
 - b) a frame comprising a plurality of vertical members externally disposed to said at least one buoyancy element and a plurality of connectors securing said vertical members to said riser, *wherein said frame is constructed to carry loads exerted by external forces.*

The Applicants' invention, as claimed in Claim 1, therefore includes a buoyancy apparatus that includes a frame that is constructed to carry loads exerted by external forces. Claim 18 contains the same language emphasized above.

Bartholomew does not contain any teaching or suggestion that the items labeled "(A)" and "(B)" by the Examiner in an attachment to the First Office Action are capable of carrying any loads exerted by external forces. Moreover, there is really no discussion of what function items (A) and (B) serve as these items are not numbered or discussed in Bartholomew. Therefore Bartholomew does not teach or suggest that Applicants' invention as claimed in Claims 1, 18, and the claims that depend therefrom.

New Claims 44 and 45, which depend from Claims 1 and 18 respectively, contain further specification of certain types of loads that are exerted by external forces that may be carried by the frame which are also not taught or suggested by Bartholomew.

None of the other references cited in the Second Office Action were cited as making any of the existing independent claims unpatentable, but only as making some of the application's dependent claims obvious. Therefore the Applicants do not believe it necessary to address the various dependent claim rejections based on the references other than Bartholomew after establishing the patentability of the independent claims over Bartholomew. Therefore the Applicants' invention as claimed in Claims 1, 18, and the claims that depend therefrom is novel and non-obvious in view of Bartholomew and the other references cited in the Second Office Action.

In the Second Office Action the Examiner states that in considering the patentability of the claims under 35 U.S.C. 103(a), the Examiner has presumed that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Out of an abundance of caution the Applicants wish for the Examiner to treat all the claims of the application as not commonly owned for the purposes of examination, including for the purpose of considering potential prior art under 35 U.S.C. 102(f) or (g).


The application is believed to be in condition for allowance. Applicants believe that the prior art does not teach or suggest, either alone or in combination, all the elements of independent Claims 1, 18 or 39. The dependent claims are also believed patentable since they depend on independent Claims 1, 18 or 39. Applicants therefore respectfully request that this application be allowed and passed to issue.

If the Examiner wishes to discuss this application with counsel, please contact the undersigned.

OFFICIAL

Respectfully submitted,

Date:

9/16/03
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I hereby certify that this correspondence is being transmitted via facsimile to Examiner Jong-Suk Lee, Technology Center 3600, United States Patent and Trademark Office at (703) 872-9326 on September 16, 2003.


Margaret Gnewuch

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